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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/469,499	12/22/99	SUGAHARA	T 041-1790B

LM01/0807  
LOWE HAUPTMAN GOPSTEIN GILMAN & BERNER  
1700 DIAGONAL ROAD  
SUITE 310  
ALEXANDRIA VA 22314

EXAMINER

LEE, Y

ART UNIT	PAPER NUMBER
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2713

8

DATE MAILED: 08/07/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
**09/469,499**

Applicant(s)  
**Takayuki Sugahara**

Examiner  
**Y. Lee**

Group Art Unit  
**2713**



☒ Responsive to communication(s) filed on Aug 2, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 18-22 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 18-22 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☒ The drawing(s) filed on Dec 22, 1999 is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☒ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☒ received in Application No. (Series Code/Serial Number) 08/940,941.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Applicant's election without traverse of species V, Figures 14-16 in Paper No. 7 is acknowledged.

### ***Priority***

2. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 08/940,941, filed on 9/30/97.

### ***Drawings***

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.
4. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: "5" in Figure 11. Correction is required.
5. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner.

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***Specification***

6. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.
7. The following title is suggested: "Reproduction Apparatus and Method for Providing User Modifiable Protection of Data Reproduction."

***Claim Objections***

8. Claims 18-22 are objected to because of the following informalities:
  - claim 18, line 6, "said" should be deleted;
  - claim 18, line 11, before "apparatus", --said-- should be inserted;
  - claim 19, line 6, "said" should be deleted;
  - claim 19, line 11, before "apparatus", --said-- should be inserted;
  - claim 20, line 6, "said" should be deleted;
  - claim 20, line 10, before "apparatus", --said-- should be inserted;
  - claim 21, line 5, "said" should be deleted; and
  - claim 22, line 6, "said" should be deleted.

Appropriate correction is required.

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***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Kilbel (5,214,556).

Kilbel, in Figures 2, 5, and 8-10, discloses a VCR protection system that is the same reproduction/decoding apparatus and method providing reproduction protection as specified in claims 18-22 of the present invention, for operating on main data which are conveyed by a data medium 50 and on medium protection data 56 which are specific to the data medium 50 and are conveyed by the data medium 50, the method and apparatus 10 comprising means for generating apparatus protection data (Fig. 9) comprising a first set of data (Fig. 8) and a second set of data (e.g. 84,86,88,95,97) such that the first set of data cannot be modified by a user of the reproduction apparatus and the second set of data can be modified by the user, the first set of data being specific to a region or a country (U.S.) in which the reproduction apparatus 10 is to be used; means for defining a protection level (Fig. 10) based on the medium protection data 56 and the apparatus protection data in combination; and means for executing reproduction (Fig. 1) of the main data in accordance with the protection level.

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### ***Double Patenting***

11. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

12. Claims 18-22 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-6 of copending Application No. 08/940,941. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the current application are broader than the ones in the parent application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Conclusion***

13. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

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Washington, D.C. 20231

**or faxed to:**

(703) 308-9051, (for formal communications intended for entry)


**Or:**

(703) 308-6306/6296 (for informal or draft communications, please label

"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive,  
Arlington. VA., Sixth Floor (Receptionist).

14. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Y. Lee whose telephone number is (703) 308-7584.

  
**Y. LEE**  
**PRIMARY EXAMINER**

Y. Lee/yl  
August 4, 2000